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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,806	08/28/2001	Naohisa Suzuki	862.C2338	2957

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EXAMINER

MASON, DONNA K

ART UNIT	PAPER NUMBER
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2111

DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/939,806

Applicant(s)

SUZUKI ET AL.

Examiner

Donna K. Mason

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

2. The drawings are objected to because in Fig. 5 (item 604), "PRIBVATE" should be changed to --PRIVATE--. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance. See 37 CFR 1.83.
3. Figures 1-26 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Applicant is advised to carefully review each of Figures 1-34, to determine whether any of these figures illustrate prior art.

Information Disclosure Statement

4. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the

list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered. (e.g., see page 19, lines 18-21).

Specification

5. The disclosure is objected to because of the following informalities:

Each of the terms of the acronym "AV/C" (e.g., on page 12, line 23) should be spelled out at the first occurrence of the acronym in the specification.

On page 38, line 15, delete "means as".

Appropriate correction is required. See 37 CFR 1.71.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 2-4, 6, 7, 9-11, 13, and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 2 recites the limitation "the address area where the configuration information is stored" in lines 3-4. Independent claim 1 recites both "a predetermined address area" where configuration information is stored and "an address area different from the predetermined address area" where configuration information is stored.

Therefore, it is unclear which "address area" is referred to in dependent claim 2.

9. Claim 3 recites the limitation "the address area where the configuration information is stored" in lines 6-7. Independent claim 1 recites both "a predetermined address area" where configuration information is stored and "an address area different from the predetermined address area" where configuration information is stored.

Therefore, it is unclear which "address area" is referred to in dependent claim 3.

10. Claim 4 recites the limitation "the address area where the configuration information is to be stored" in lines 1-3. Independent claim 1 recites both "a predetermined address area" where configuration information is stored and "an address area different from the predetermined address area" where configuration information is stored. Therefore, it is unclear which "address area" is referred to in dependent claim 2.

11. Claim 6 recites the limitation "the address area where the configuration information is stored" in lines 3-4. Independent claim 5 recites both "a predetermined address area" where configuration information is stored and "an address area different from the predetermined address area" where configuration information is stored.

Therefore, it is unclear which "address area" is referred to in dependent claim 6.

12. Claim 7 recites the limitation "the address area where the configuration information is to be stored" in lines 1-3. Independent claim 5 recites both "a predetermined address area" where configuration information is stored and "an address area different from the predetermined address area" where configuration information is stored. Therefore, it is unclear which "address area" is referred to in dependent claim 7.

13. Claim 9 recites the limitation "the address area where the configuration information is stored" in lines 3-4. Independent claim 8 recites both "a predetermined

address area” where configuration information is stored and “an address area different from the predetermined address area” where configuration information is stored.

Therefore, it is unclear which “address area” is referred to in dependent claim 9.

14. Claim 10 recites the limitation “the address area where the configuration information is stored” in lines 6-7. Independent claim 8 recites both “a predetermined address area” where configuration information is stored and “an address area different from the predetermined address area” where configuration information is stored.

Therefore, it is unclear which “address area” is referred to in dependent claim 10.

15. Claim 11 recites the limitation “the address area where the configuration information is to be stored” in lines 1-3. Independent claim 8 recites both “a predetermined address area” where configuration information is stored and “an address area different from the predetermined address area” where configuration information is stored. Therefore, it is unclear which “address area” is referred to in dependent claim 11.

16. Claim 13 recites the limitation “the address area where the configuration information is stored” in lines 3-4. Independent claim 12 recites both “a predetermined address area” where configuration information is stored and “an address area different from the predetermined address area” where configuration information is stored.

Therefore, it is unclear which “address area” is referred to in dependent claim 13.

17. Claim 14 recites the limitation “the address area where the configuration information is to be stored” in lines 1-3. Independent claim 12 recites both “a predetermined address area” where configuration information is stored and “an address

area different from the predetermined address area" where configuration information is stored. Therefore, it is unclear which "address area" is referred to in dependent claim 14.

Claim Rejections - 35 USC § 102

18. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

19. Claims 1-14 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,991,842 to Takayama.

As shown in Fig. 7, Takayama discloses an information processing apparatus including: an interface (Fig. 7, item 5) arranged to connect to a serial bus (Fig. 7, item 13) compatible to or complying with the IEEE 1394 standard; and a memory (Fig. 7, items 8 and 9) arranged to store, in a predetermined address area, configuration ROM information complying with the IEEE 1212 standard (see column 4, lines 23-31) and to store configuration information identical to the configuration ROM information in an address area different from the predetermined address area (column 10, lines 20-23).

Therefore, Takayama reads on the invention as claimed.

Claim Rejections - 35 USC § 103

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20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takayama in view of U.S. Patent No. 6,643,714 to Chrysanthakopoulos.

As shown in Fig. 7, Takayama discloses an information processing apparatus including: an interface (Fig. 7, item 5) arranged to connect to a serial bus (Fig. 7, item 13) compatible to or complying with the IEEE 1394 standard; and a memory (Fig. 7, items 8 and 9) arranged to store, in a predetermined address area, configuration ROM information complying with the IEEE 1212 standard (see column 4, lines 23-31) and to store configuration information identical to the configuration ROM information in an address area different from the predetermined address area (column 10, lines 20-23).

Takayama does not expressly disclose a computer program product including a computer readable medium storing a computer program code, for an information processing method of processing information between a plurality of devices connected to a serial bus compatible to or complying with the IEEE 1394 standard, including process procedure code.

Chrysanthakopoulos discloses a computer program product including a computer readable medium storing a computer program code, for an information processing method of processing information between a plurality of devices connected to a serial

bus compatible to or complying with the IEEE 1394 standard, including process procedure code (Fig. 1, items 142, 145, 190, 192, 195, 196, 197, and 198).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Chrysanthakopoulos with Takayama. The suggestion or motivation for doing so would have been to provide a removable storage medium, which can also serve as a back-up medium.

Therefore, it would have been obvious to combine Chrysanthakopoulos with Takayama to obtain the invention as specified in claims 15 and 16.

Conclusion

22. A shortened statutory period for reply is set to expire THREE MONTHS from the mailing date of this communication. Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this communication.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donna K. Mason whose telephone number is (703) 305-1887. The examiner can normally be reached on Monday - Friday, 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark H. Rinehart can be reached on (703) 305-4815. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DKM



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